



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,223	12/21/2004	Georg Gros	DNAG-293	2138
24972 7590 12/12/2007 FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			EXAMINER VIJAYAKUMAR, KALLAMBELLA M	
			ART UNIT	PAPER NUMBER
			1793	
			MAIL DATE	DELIVERY MODE
			12/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/511,223

Applicant(s)

GROS, GEORG

Examiner

Kallambella Vijayakumar

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 104-140 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 104-140 is/are rejected.
- 7) ☒ Claim(s) 109-112, 124, 128, 129, 132, 133 and 138 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

- Claims 64-103 cancelled. New Claims 104-140 are currently pending with the application.

Claim Objections

- Claims 109-112 and 132-133 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim reciting the "a) is at least one electrically conductive or semiconducting metallic particle selected from the group consisting of tungsten, molybdenum, tantalum and niobium and alloys thereof,." Claims 132-133 depend on claims that are objected to. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.
- Claims 124, 128-129 and 138 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims 128-129 do not further limit the process of coating in claim-117.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 109-112, 119, and 121-122 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 109-112, 119, and 121-122 recite the limitation of "the electrically conductive or semiconducting hard particles a)" and there is insufficient antecedent basis for this limitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 104, 113, 116 and 139 are rejected under 35 U.S.C. 102(b) as being anticipated by Leon et al (US 3,562,124).

The use of phrase "for a chromate free process" in the claim-104 has not been treated with patentability. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The examiner makes of record that instant claim 104 recites a broad range of components (A is from 0.5-70 wt% of the mixture) followed by a series of narrow ranges (A is present in an amount of from 4.5 to 70 wt% of the mixture). For examination purposes, the examiner asserts that the narrow ranges recited in instant claim-104 are merely exemplary ranges, and thus, the prior art will be applied against the broadest ranges recited in instant claim 104. Furthermore, the examiner suggests that applicant should delete the narrow ranges from instant claim-104, and add new dependent claims that recite the narrow ranges recited in instant claim-104.

Leon et al teach the corrosion protection coating liquid comprising an 3-50 wt% organic binder such as an epoxy (CI-5, Ln 21-25; CI-2, Ln 35-44) and 20-95 wt% of a filler comprising conductive metal particles such as zinc, aluminum or magnesium (CI-2, Ln 54-59; CI-3, Ln 17-28). 10-85 wt% of the filler contained comminuted ferro alloy such as **ferromolybdenum** and **ferrotungsten** (CI-3, Ln 13-16; 33-36). The coating composition contained 5-60 wt% solvents, and up to 70 wt% of curing agent and plasticizers

such as castor oil or chlorinated paraffin (CI-4, Ln 43-66). The composition meets the ratio limitations and characteristics of the components and composition in the claims. The prior art further teaches the addition of magnesium montmorillonite, a silicate based additive in the coating composition (CI-5, Ex-1, Ln 67). The particle size of the conductive fillers 1-5 micron for the ferro alloys (CI-3, Ln 67-70). The prior art further teaches coating a metallic substrate and forming films in the range of about 0.5-5.0 mils (CI-5, Ln 2-8). All the limitations of the instant claims are met.

The reference is anticipatory.

2. Claims 104-108, 117-136 and 139-140 are rejected under 35 U.S.C. 102(e) as being anticipated by Reising et al (US 6,715,916).

Reising et al teach a coating composition for weldable substrates comprising one or more conductive pigments comprising Al, Zn, **W**, **Graphite** and ferrophos (A/a) with a particle size of ~1 to ~5 microns, preferably ~ 3 micron, and in the amount of ~30 to ~60 by volume % that will meet the component ratio when calculated in terms of wt%. Graphite makes the conductive particles sliding because of its layered structure. The binder comprised of resins such as epoxy or polyurethane in the amount of ~10 to ~20 wt% (CI-6, Ln 1-17). The composition further contained crosslinkers such as cymel and/or blocked isocyanates and a solvent and the pigment to binder ratio was ~10 to ~50 wt% (CI-6, Ln 34-64; CI-9, Ln 43-48) that meets the ratio limitations in claim-104 and size limitations in claims 105-108. The coating composition further contains hydrogenated or sulfated castor oil and pigments such as magnesium silicate (CI-7, Ln 4-11). With regard to process claims 117-118, 123-124 and 126-131 the prior art teaches applying the coating over the substrates such as steel by degreasing the substrate with a degreaser, optionally applying a pretreatment, coating the composition and curing at a temperature up to ~ 300C peak metal forming a coating with a thickness of 3-8 micron (CI-4, Ln 22-30, 53-65, CI-5, Ln 10-20; CI-7, Ln 32-47; CI-8, Ln 4-7). With regard to the process steps in claim 120, the examiner asserts that the prior art coating will be either same or substantially same as that produced by the claimed process steps. The prior art does not teach the addition of organic lubricants or PTFE that meets the limitation of claims 125 and 130.

With regard to claims 134-136 and 139-140, the prior art teaches the composition containing blocked isocyanates, urea-melamine derivatives and tungsten and coating the film over a metal substrate (CI-5, Ln 45; CI-6, Ln 39-41; CI-8, Ln 4-7; CI-9, Ln 44-49). All the limitations of the instant claims are met.

The reference is anticipatory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 105-108, 117, 120, 123-131, 134, 136-138 and 140 are rejected under 35 U.S.C. 103(a) as obvious over Leon et al (US 3,562,124).

The disclosure on the corrosion protection coating liquid comprising by Leon et al as set forth in rejection-1 under 35 USC 102(b) is herein incorporated.

The prior art fails to teach the instant claimed particle sizes in claims 105-108, a film thickness of less than 6 micron per claims 117, 124 or 140; or the particle size of Mg-morrillonite <silicate based pigment> per claims 134 and 137-138.

With regard to the particle sizes in claims 105-108, the prior art particle sizes of the ferro fillers overlaps over the instant claimed ranges, and In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

With regard to the film thickness of less than 6 micron in claims 117, 124 and 140, the prior art teaches varying the thickness of the coated film and further suggestive that the thickness outside the typical range of 0.5 to 5.0 mil could be used depending upon the particular conditions of application and intended use, and it would have been obvious to a person of ordinary skilled in the art to optimize the coating thickness as a choice of design of intended application with reasonable expectation of success. Generally, differences in concentration or temperature or thickness will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature or thickness is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

With regard to the process steps in claims 120 and 123, the prior art teaches grinding and mixing the components forming a coating liquid, and coating a steel substrate forming a protective layer over the substrate (Cl-3, Ln 72 – Cl-4, Ln 41), and the examiner asserts that the prior art coating will be either same or substantially same as that produced by the claimed process steps.

With regard to claims 125 and 130, the prior art does not add either organic lubricants or PTFE.

With regard to claims 126-129 and 131, the prior art teaches coating ferrous metals. Further, with regard to product by process limitation in claims 128-129, the prior art product is either same or substantially same as that claimed by the applicants and When the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process, the claim is not patentable. See In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) And In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP §2113.

With regard to claims 134 and 136-138, the prior art teaches composition containing magnesium montmorillonite, and using conductive fillers with a particle size of 1-5 micron and forming coated layers over the substrate that is as low as 12.7 micron, and the claimed upper limit of 5/6 micron for the Mg-montmorillonite would have been obvious in the prior art composition.

2. Claims 116 and 137-138 are rejected under 35 U.S.C. 103(a) as obvious over Reising et al (US 6,715,916).

Reising's teaching on a coating composition for weldable substrates as set forth in rejection-2 under 35 USC 102(e) is herein incorporated.

The prior art is silent about the amount of castor oil derivative added per claim 116 and particle size of Magnesium silicate per claims 137-138.

The prior art teaches the addition of castor oil derivative and any trivial amount of the component would meet the limitation of not more than 1.5 wt% ($0 < x \leq 1.5$, $x = \text{amt. added}$) in claim 104.

The instant claimed particle size for Mg-silicate <pigment> would be obvious over the prior art film thickness of 3-8 micron.

3. Claims 104-108, 109-112, 113, 115-138 are rejected under 35 U.S.C. 103(a) as obvious over Wiechelhaus et al (WO 99/24545) in view of either Reising et al (US 6,715,196) or Mosser et al (US 4,724,172).

The US patent 6,479,103 issued to Wiechelhaus et al is being used as the English Translation of the WO Document.

Wiechelhaus et al teach the composition of a corrosion resistant and weldable coating composition comprising 10 to 40 wt. % of an organic binder; 0 to 15 wt.% of a silicate-based anti-corrosive pigment, 40 to 70 wt.% of powdered zinc, aluminum <hard particles>, graphite and/or molybdenum disulfide, iron phosphide <hard particle> or BaSO₄ doped with Sn or Sb, together with 0 to 30 wt.% of a solvent, wherein the organic binder consists of at least one epoxy, at least one curing agent selected from guanidine, substituted, guanidines, substituted ureas, cyclic tertiary amines and mixtures thereof,

together with at least one -blocked polyurethane resin (Abstract; CI-3, Ln 1-29; CI-5, Ln 49-64; Tables 1-3; CI-6, Ln 34). The wt % of the components meets the limitation component ratios in the claim-104. The composition further contained lubricants, soluble dyes and coloring pigments.

The prior art fails to teach the composition containing the specific metal/alloy particles per the claim-104 and 139.

In the analogous art, Reising et al teach the weldable corrosion resistant coatings for metal substrates containing Zn, Al, graphite, Ni, W and their mixtures there of (Abstract, CI-5, Ln 39-55).

In the analogous art Mosser et al teach corrosion and oxidation resistant coatings for metal substrates containing Al or Al alloys and metallic powders/pigment such as Zn, W and Mo (Abstract, CI-13, Ln 3-15).

It would have been obvious to a person of ordinary skilled in the art to substitute either al or Zn in the composition of Wiechelhaus et al with the fillers of either Reising et al or Mosser et al as functional equivalent with predictable results because the teachings are in the analogous art of weldable corrosion resistant coatings or corrosion resistant coatings for metal substrates the Species of Al/Zn are encompassed by the genus of fillers by Reising or Mosser.

With regard to claims 105-108, the prior art teaches coating 2-5 micron layers over the metals, and the instant claimed particle sizes would be obvious in the prior art composition.

With regard to claim 115, the prior art teaches adding cyclic tertiary amines.

With regard to claim-116, the prior art teaches adding 0.2% modified castor oil (Table-1).

With regard to claims 117-118, 123-131 and 140, the prior art teaches coating a metal by cleaning the steel sheet metal, optionally chromated <precoated>, further coating the composition over the metal surface and drying the coating at a peak metal temperature of 180-235C forming 2-5 micron thick coating (CI-6, Ln 9-17). With regard to the process steps in claim 120, the examiner asserts that the prior art coating will be either same or substantially same as that produced by the claimed process steps.

With regard to claims 134-136, the prior art teaches adding a mixture of polyurethane and MDI (CI-5, Ln 19-23).

With regard to claims 134, and 136-138, the instant claimed particle size of silicate based pigment would be obvious over 2-5 micron layers over the metallic substrate.

4. Claims 104, 109-112, 115 and 132-139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soltwedel (US 6,008,462) in view of either Reising et al (US 6,715,196) or Mosser et al (US 4,724,172).

Soltwedel teaches a mar resistant corrosion inhibiting weldable coating for metals comprising organic binders, 30-40 wt% metallic fillers such as iron passing through -325 mesh sieve (<44 micron) or ultrafine Fe (<0.2 micron), 0.4-0.6 wt% silica/silicate suspension agent, 0.5-1wt% PTFE lubricant, 1—20 wt% inorganic fillers such as oxides, crosslinker, solvent, catalysts such as tertiary amines, lubricants such as molybdenum disulfide or fatty acid salts and 3-10 wt% corrosion inhibiting agents such as zinc with a particle size of 2-6 micron and solvents (Abstract, Cl-4, Ln 22-41; Cl-7, Ln 11-17; Cl-8, Ln 25-30; Cl-9, Ln 35-59; Cl-10, Ln 38-40, Ln 60-67; Cl-13-14, Table-1). The weldable coating was about 0.4-0.6 mil (10-15 micron) (Cl-13, Ln 9-15). The composition given in Example-1 meets the component ratio limitations in the claim-104.

The prior art fails to teach the composition containing the specific metal/alloy particles per the claim-104 and 139, or the particle sizes per claims 105-108.

In the analogous art, Reising et al teach the weldable corrosion resistant coatings for metal substrates containing Zn, Al, graphite, Ni, W and their mixtures there of (Abstract, Cl-5, Ln 39-55).

In the analogous art Mosser et al teach corrosion and oxidation resistant coatings for metal substrates containing Al or Al alloys and metallic powders/pigment such as Zn, W and Mo (Abstract, Cl-13, Ln 3-15).

It would have been obvious to a person of ordinary skilled in the art to substitute Zn in the composition of Soltwedel et al with the fillers of either Reising et al or Mosser et al as functional equivalent with predictable results because the teachings are in the analogous art of weldable corrosion resistant coatings or corrosion resistant coatings for metal substrates the Species of Zn are encompassed by the genus of fillers by Reising or Mosser.

With regard to claims 105-108, the instant claimed particle size would be obvious over the weldable coating thickness of about 0.4-0.6 mil (10-15 micron) (CI-13, Ln 9-15).

With regard to claims 109-111 and 132-133, the prior art teaches a composition containing 8.42 wt% titania (Example-1) that is close to claimed at least 10 wt%, and a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of "having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium" as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.).

With regard to claims 134-136, the prior art teaches adding blocked isocyanates (CI-14, Ln-5).

With regard to claims 134 and 136-139, the prior art teaches the addition of fumed silica and quaternary amine treated Mg-Al-silicate, and the instant claimed particle size would be obvious over the weldable coating thickness of about 0.4-0.6 mil (10-15 micron) (CI-13, Ln 9-15).

5. Claims 104-108, 114 and 139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al (5,976,419) in view of either Reising et al (US 6,715,196) or Mosser et al (US 4,724,172).

Hawkins et al teach a coating composition containing a resin binder such as epoxy or polyurethane, ICP polymers such as polyaniline, metal particles such as Mg, Zn and Al and their alloys (Al-130, particle size 1-2 micron, See Data Sheet), plasticizers, curing agent and additives including solvent (Abstract, CI-3, Ln 43-CI-4, Ln 25). The typical compositions in Examples 1-3 give the ratio of the components in the coating composition wherein the binder ranged from 51-54 wt% for the examples. The prior art conductive filler ratios in vol% when calculated overlapped with instant claimed wt% ratios for conductive fillers.

The prior art fails to teach the instant claimed ratio of binders per claim-104 and the specific metal/alloy particles per the claim-104 and 139.

In the analogous art, Reising et al teach the weldable corrosion resistant coatings for metal substrates containing Zn, Al, graphite, Ni, W and their mixtures thereof (Abstract, Cl-5, Ln 39-55).

In the analogous art Mosser et al teach corrosion and oxidation resistant coatings for metal substrates containing Al or Al alloys and metallic powders/pigment such as Zn, W and Mo (Abstract, Cl-13, Ln 3-15).

It would have been obvious to a person of ordinary skill in the art to substitute Al/Zn in the composition of Hawkins et al with the fillers of either Reising et al or Mosser et al as functional equivalent with predictable results because the teachings are in the analogous art of weldable corrosion resistant coatings or corrosion resistant coatings for metal substrates the species of Zn are encompassed by the genus of fillers by Reising or Mosser.

Further, the prior art teaches exemplary compositions containing 51-54 vol% binders that is close to claimed ratio of 42 wt%, and a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of "having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium" as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.).

With regard to claims 105-108, the prior art teaches conductive filler with a particle size of 1-2 micron.

With regard to claim 114, the prior art teaches PANI.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226

(Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 104-108, 112, 116, 134 and 136 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 31-35, 38, 40, 46, 47, 50, 56, 69-70 of copending Application No. 10/511242. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and copending application are drawn to similar compositions having similar components and same utility as conductive coatings, while the instant claims contain specific ranges of components and differ from the copending claims that do not have the ranges, and it would be obvious to a person of ordinary skilled in the art to optimize the composition for coating applications because they are well known in the art (See Wiechelhaus et al (WO 99/24545)).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action

Application/Control Number:
10/511,223
Art Unit: 1793

Page 13

is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kallambella Vijayakumar whose telephone number is 571-272-1324. The examiner can normally be reached on 6.30-4.00 Mon-Thu, 6.30-2.00 Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KMV/



J. A. LORENZO
SUPERVISORY PATENT EXAMINER